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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,412	02/04/2004	Ming Te Lai	BHT-3207-34	1926

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EXAMINER
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DICUS, TAMRA

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/770,412

Applicant(s)

LAI, MING TE

Examiner

Tamra L. Dicus

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7-12 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims to the various showings (e.g. showing costumes, animals, beads, and flowering plants), are not supported by the instant specification as the specification does not describe how these showings are generated e.g. (printed with a printer or assembled with actual objects). See specification page 9, line 25-line 20 and page 11, lines 10-15. Further the only sticker shown is 90 in FIG. 5 and FIG. 6-9 do not show that these showings are actual stickers if that is the intent.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-4 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. The term "thin" in claims 2-3 and "close" in claims 4 and 14 are relative terms which renders the claim indefinite. The term "thin" and "close" is not defined by the claim, the

Art Unit: 1774

specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

### ***Drawings***

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: The only sticker shown is 90 in FIG. 5 and FIG. 6-9 do not show that these showings are actual stickers if that is the intent. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 2, 4, 7-14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 5,458,231 to Belokin et al.

Tamanini teaches a bag-packed decorative sticker set, comprising: a packing bag defining a receiving space (20, Fig. 1 and associated text), said packing bag including a sealed upper edge and an open lower edge, and flap downward extended from said open lower edge; said flap being normally folded upward to close an opening at said open lower edge and adapted to turn downward again expose said opening (see flap at top of 20); a substrate having a size suitable for positioning in said packing bag (22, Fig. 1 and associated text), and a front allowing an adhesive-applied surface to repeatedly detachably attached thereto (release 22 and adhesive stickers 26 thereon allow this to happen); and a set of individual decorative stickers together creating specific view (26, Figs. 1 and 2 and associated text), said decorative stickers being preliminarily detachably adhered at an adhesive-applied backside to the front of said substrate (26, 22, Figs. 1 and 2 and associated text), so as to be positioned into or removed from said packing bag along with said substrate (Fig. 1 and associated text). Tamanini teaches the substrate is a release paper which is opaque and thin. (Instant claims 1, 2, 12, and 13).

Tamanini teaches a card having information on it about the use (col. 6, lines 50-55) and attached to upper surfaces of what's shown (24, Fig. 1 and associated text, the sticker substrate is adjacent to the card, and this is interpreted as the upper surfaces of what's shown) (instant claims 4 and 14). The size of the card appears approximately half the size of the substrate paper, and is interpreted as close in size. Further, it would have been obvious to produce a different size as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.

Tamanini does not teach an adhesive-applied flap or being adapted to hang on a display rack or rail (instant claims 1 and 12).

Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein (col. 2, lines 44-55) and being adapted to hang on a display rack or rail (col. 2, lines 55-61) so that the packaging goods inside may be suspended in a showcase or the like.

It would have been obvious to one having ordinary skill in the art to have modified the bag of Tamanini because Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein and being adapted to hang on a display rack or rail so that the packaging goods inside may be suspended in a showcase or the like (col. 2, lines 44-55 and col. 2, lines 55-61 of Yamagagta).

Tamanini does not teach the stickers are three-dimensional (3D).

However, Tamanini does teach the stickers have a symbol that may be chosen to suit the particular occasion or may be a mere pattern (col. 6, lines 35-48).

Belokin teaches 2D and 3D stickers to yield a different design such as a butterfly or holographic dinosaurs and the like displaying a dramatic exhibit (col. 1, lines 9-15 and col. 2, lines 30-33).

It would have been obvious to one having ordinary skill in the art to have modified the combination because Tamanini suggests stickers may have a generic pattern or design and Belokin teaches 2D and 3D removably attached stickers to yield a different design such as a butterfly or holographic dinosaurs and the like displaying a dramatic exhibit (col. 1, lines 9-15 and 42-44, and col. 2, lines 30-33).

To the various designs of the stickers including costumes, animals, beads, flowering plants, women's personal items of instant claims 7-12 and 17, it would have been obvious to one

having ordinary skill in the art to have modified the combination to provide stickers any design due to the desired end use as Tamanini explains (col. 6, lines 35-48 of Tamanini).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 5,458,231 to Belokin et al. and further in view of USPN 5,989,667 to Tayebi.

Tamanini teaches the substrate is a release paper, but does not teach a transparent substrate (instant claim 3).

Tayebi teaches a sticker of paper or transparent film (thin) (col. 4, line 30-41) as an equivalent support.

It would have been obvious to one having ordinary skill in the art to have modified the combination to use a transparent thin sheet because Tayebi teaches a sticker of paper or transparent film (thin) as an equivalent support (col. 4, line 30-41 of Tayebi).

9. Claims 1, 2, and 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 4,968,540 to Linsenbigler.

Tamanini teaches a bag-packed decorative sticker set, comprising: a packing bag defining a receiving space (20, Fig. 1 and associated text), said packing bag including a sealed upper edge and an open lower edge, and flap downward extended from said open lower edge; said flap being normally folded upward to close an opening at said open lower edge and adapted to turn downward again expose said opening (see flap at top of 20); a substrate having a size suitable for positioning in said packing bag (22, Fig. 1 and associated text), and a front allowing an adhesive-applied surface to repeatedly detachably attached thereto (release 22 and adhesive stickers 26

Art Unit: 1774

thereon allow this to happen); and a set of individual decorative stickers together creating specific view (26, Figs. 1 and 2 and associated text), said decorative stickers being preliminarily detachably adhered at an adhesive-applied backside to the front of said substrate (26, 22, Figs. 1 and 2 and associated text), so as to be positioned into or removed from said packing bag along with said substrate (Fig. 1 and associated text). Tamanini teaches the substrate is a release paper which is opaque and thin. (Instant claims 1, 2, 12, and 13).

Tamanini teaches a card having information on it about the use (col. 6, lines 50-55) and attached to upper surfaces of what's shown (24, Fig. 1 and associated text, the sticker substrate is adjacent to the card, and this is interpreted as the upper surfaces of what's shown) (instant claims 4 and 14). The size of the card appears approximately half the size of the substrate paper, and is interpreted as close in size. Further, it would have been obvious to produce a different size as it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284.

Tamanini does not teach an adhesive-applied flap or being adapted to hang on a display rack or rail (instant claims 1 and 12).

Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein (col. 2, lines 44-55) and being adapted to hang on a display rack or rail (col. 2, lines 55-61) so that the packaging goods inside may be suspended in a showcase or the like.

It would have been obvious to one having ordinary skill in the art to have modified the bag of Tamanini because Yamagagta teaches a packaging having an adhesive-applied flap for sealing purposes and folded to completely seal a bag opening to contain the goods therein and

Art Unit: 1774

being adapted to hang on a display rack or rail so that the packaging goods inside may be suspended in a showcase or the like (col. 2, lines 44-55 and col. 2, lines 55-61 of Yamagata).

Tamanini does not teach the stickers are three-dimensional (3D) (instant claims 1 and 12) nor that the stickers are formed by curling paper of a predetermined width (instant claims 5-6 and 15-16).

However, Tamanini does teach the stickers have a symbol that may be chosen to suit the particular occasion or may be a mere pattern (col. 6, lines 35-48).

Linsenbigler teaches a 3D sticker such as a bow having curled paper of predetermined widths and overlapping fashion (instant claims 5-6 and 15-16) (Fig. 3 and col. 4, lines 25-68).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include three-dimensional (3D) stickers that are formed by curling paper of a predetermined width because Linsenbigler teaches a 3D sticker such as a bow having curled paper of predetermined widths and overlapping fashion as a design used in packages, envelopes and greeting cards (Fig. 3, col. 3, lines 40-46, and col. 4, lines 25-68 of Linsenbigler).

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,295,695 to USPN 5,295,695 to Tamanini in view of USPN 4,084,689 to Yamagata and further in view of USPN 4,968,540 to Linsenbigler and further in view of USPN 5,989,667 to Tayebi.

Tamanini teaches the substrate is a release paper, but does not teach a transparent substrate (instant claim 3).

Tayebi teaches a sticker of paper or transparent film (thin) (col. 4, line 30-41) as an equivalent support.

Art Unit: 1774

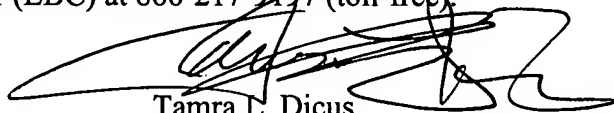
It would have been obvious to one having ordinary skill in the art to have modified the combination to use a transparent thin sheet because Tayebi teaches a sticker of paper or transparent film (thin) as an equivalent support (col. 4, line 30-41 of Tayebi).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamra L. Dicus whose telephone number is 571-272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tamra L. Dicus  
Examiner  
Art Unit 1774

February 11, 2006



RENA DYE  
SUPERVISORY PATENT EXAMINER

A.U. 1774 215104